IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/693,321	§	Examiner: Singh, Rachna
Filed: October 19, 2000	§	Group/Art Unit: 2176
Inventors:	§	Atty. Dkt. No: 5181-57700
Mohamed M. Abdelaziz, et al.	§	
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Title: DYNAMIC DISPLAYS IN A DISTRIBUTED COMPUTING ENVIRONMENT	§	
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PETITION UNDER 37 CFR 1.181(a) REQUESTING WITHDRAWAL OF HOLDING OF ABANDONMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

New grounds of rejection were stated by the Examiner is the Examiner's Answer mailed July 26, 2006. Pursuant to 37 CFR 41.39(b)(1), Applicants timely requested that prosecution be reopened and submitted an amendment and response under 37 CFR 1.111. The Examiner mailed a Notice of Abandonment on March 29, 2007 holding the present application abandoned on the grounds that Applicants' amendment and response under 37 CFR 1.111 was not "relevant to the new ground of rejection" as required by 37 CFR 41.39(b)(1). Applicants request withdrawal of the holding of abandonment for the reason that, as explained in more detail below, Applicants' amendment and response under 37 CFR 1.111 was in full compliance with 37 CFR 41.39(b)(1). Applicants also request withdrawal of the holding of abandonment for the additional reason that, as explained in

more detail below, the Examiner's new ground of rejection was not permissible in the Examiner's Answer and should have instead been made in a new Action reopening prosecution as required by MPEP § 1207.03.II.

1. Applicants' amendment and response filed September 29, 2006 under 37 CFR 1.111 was in full compliance with 37 CFR 41.39(b)(1).

In the Notice Abandonment, the Examiner asserts that the amendment filed by Applicants on September 29, 2006 is not relevant to the new rejection presented in the Examiner's Answer of July 26, 2006. In particular, the Examiner asserts that the new ground of rejection was made to address the interpretation of the term "service". The Examiner asserts that Applicants' amendment does not attempt to define or clarify the definition of the term "service".

Contrary to the Examiner's assertions, Applicants' response was directly relevant to the new ground of rejection. In regard to the independent claims, the Examiner's original rejection on appeal was based on the standard of anticipation under 35 USC § 102(e). The Examiner's new ground of rejection is based on the obviousness standard under 35 USC § 103(a). Although the Examiner's *subjective reason* for the new amendment may have been to address the term "service", the *objective effect* of the new ground of rejection was to change the rejection from being based on the anticipation standard to being based on the obviousness standard. Thus, by making the new ground of rejection after appeal, the Examiner opened the door for the reference to be considered on appeal under the obviousness standard and not just the anticipation standard. The fact that the Examiner's subjective reason for the new ground of rejection was to address the term "service" does not change the fact that the Examiner applied an entirely new standard of rejection under § 103(a) in the new ground of rejection after appeal. When Applicants' re-examined the rejection under the newly asserted obviousness standard, Applicants' decided that it would be prudent to amend the claims to advance prosecution. Thus, Applicants' amendment was directly relevant to the Examiner's new ground of rejection based on the obviousness standard.

The purpose of allowing Applicants to reopen prosecution and amend the claims in response to a new ground of rejection in an Examiner's Answer is that it would not be fair to allow the examiner to change the basis for rejection at such a late date (after appeal) and not allow applicants a chance to amend the claims in response. Here, since the Examiner has changed the standard for rejection from the anticipation standard to the obviousness standard, Applicants must be given the opportunity to amend the claims in response.

Moreover, contrary to the Examiner's assertion, Applicants' amendment and response does directly serve to further define and clarify the "service" recited in the claim. In a distributed computing environment a service is defined by the functions it performs and by its role. Applicants' amendments to the independent claims serve to further clarify and define the role of the service and what functions are performed by the service. For example, claim 1 was amended to further define the service as executing on a device separate from the process that accesses the schema and presents the results. Thus, claim 1 was amended to clarify that a process on one device performs the acts of accessing a presentation schema, accessing the results data, and presenting the results data, whereas it is the service on a separate device that generates the results data and provides the presentation schema. Therefore, the amendment is certainly relevant to clarifying the role and context of the "service" in Applicants' invention. Applicants' response also explains how the amended claims overcome the new ground of rejection. Thus, Applicants' amendment and response filed September 29, 2006 under 37 CFR 1.111 directly addressed and was relevant to the new ground of rejection.

According to MPEP § 1207.03.V.A:

> If appellant requests that prosecution be reopened, the appellant must file a reply that addresses each new ground of rejection set forth in the examiner's answer in compliance with 37 CFR 1.111 within two month from the mailing of the examiner's answer. The reply may also include amendments, evidence, and/or arguments directed to claims not subject to the new ground of rejection or other rejections. If there is an after-final

> amendment (or affidavit or other evidence) that was not entered, appellant may include such amendment in the reply to the examiner's answer.

This section of the MPEP states that the reply under 37 CFR 1.111 must address each new ground of rejection. Thus, the requirement under 37 CFR 41.39(b)(1) is the same as for any reply filed under 37 CFR 1.111, i.e., that the reply address the rejection(s). Applicants' reply filed September 29, 2006 clearly addresses the new ground of rejection. If the new ground of rejection had been made in a non-final action, Applicants' reply would clearly have been compliant under 37 CFR 1.111. The standard is no different here. The requirement under 37 CFR 41.39(b)(1) and 37 CFR 1.111 is simply that the reply be relevant, i.e., address the rejection. If a reply made no attempt to overcome a rejection, then it would not be relevant. But a reply that does address the rejection is clearly compliant with 37 CFR 1.111 37 and CFR 41.39(b)(1). The Examiner cannot force Applicants to address a rejection in only the way that the Examiner would like. To the contrary, Applicants are free to address a new ground of rejection however they may choose, as long as the rejection is addressed. The new ground of rejection is clearly addressed in Applicants' reply filed September 29, 2006. Applicants also point out that a reply under 37 CFR 41.39(b)(1) is not non-compliant just because it makes other amendments in addition to addressing the new ground of rejection. The above quoted portion of MPEP § 1207.03.V.A is clear that other amendments are permissible as long as the new ground of rejection is addressed.

Thus, for at least the above reasons, Applicants' amendment and response filed September 29, 2006 under 37 CFR 1.111 was in full compliance with 37 CFR 41.39(b)(1). Applicants request withdrawal of the holding of abandonment. Applicants further request that prosecution be reopened and entry of the amendment of September 29, 2006.

2. The Examiner's new ground of rejection was not permissible in the Examiner's Answer and should have instead been made in a new Action reopening prosecution as required by MPEP § 1207.03.II.

According to MPEP § 1207.03.II, "if an appellant has clearly set forth an argument in a previous reply during prosecution of the application and the examiner has failed to address that argument, the examiner would not be permitted to add a new ground of rejection in the examiner's answer to respond to that argument but would be permitted to reopen prosecution, if appropriate." During prosecution Applicants argued that the cited reference did not teach the claimed service as properly interpreted. In particular, in Applicants' response filed January 23, 2006 and in the Appeal Brief, Applicants pointed out that **the Examiner had not addressed Applicants' argument** that the separate modeling engine and legacy application of the cited reference did not teach a single service that both generates the results data and provides the presentation schema. Applicants' argument in the Appeal Brief was the same as during prosecution. On p. 17 of the Examiner's Answer, the Examiner states that he is "providing an alternate rejection under 103(a) using an alternative interpretation asserted by appellant with regards to the term 'service'." Thus, the Examiner is addressing Applicants' argument for the first time in the new ground of rejection. Per MPEP § 1207.03.II, "if an appellant has clearly set forth an argument in a previous reply during prosecution of the application and the examiner has failed to address that argument, the examiner would not be permitted to add a new ground of rejection in the examiner's answer to respond to that argument but would be permitted to reopen prosecution, if appropriate." Therefore, the new ground of rejection was not permissible in the Examiner's Answer and should have been made in a new Action reopening prosecution.

For the reasons stated above, Applicants assert that the Examiner improperly held the application to be abandoned. Applicants request withdrawal of the holding of abandonment. Applicants further request that prosecution be reopened and entry of the amendment of September 29, 2006.

CONCLUSION

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5181-57700/RCK.

Respectfully submitted,

/Robert C. Kowert/
Robert C. Kowert, Reg. #39,255
ATTORNEY FOR APPLICANT(S)

Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C.
P.O. Box 398
Austin, TX 78767-0398
Phone: (512) 853-8850

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